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| 10/815,010      | 03/31/2004  | Rajesh V. Mehta      | 87486AJA            | 9247             |

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06/15/2006

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| EXAMINER |
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BASHORE, ALAIN L

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| ART UNIT | PAPER NUMBER |
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1762

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/815,010

Applicant(s)

MEHTA ET AL.

Examiner

Alain L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sievers et al in view of Wilson et al (EP '424).

Sievers discloses a process for applying a desired substance on a surface. A particle formation vessel is charged, the temperature and pressure in which are controlled, with a compressed fluid. There is introduced into the particle formation vessel at least a first feed stream comprising at least a solvent and the desired substance dissolved therein through a first feed stream introduction port and a second feed stream comprising the compressed fluid through a second feed stream introduction port. The feed stream is dispersed in the compressed fluid, allowing extraction of the solvent into the compressed fluid and precipitation of particles of the desired substance (col 7, lines 50-65; col 8, lines 5-10).

Sievers et al does not explicitly disclose a rate substantially equal to a rate of addition of such components to the while maintaining temperature and pressure in the vessel at a desired constant level, such that formation of particulate material in the vessel occurs under essentially steady-state conditions

Wilson et al (EP '424). Discloses exhausting the compressed fluid, solvent and the desired substance from the particle formation vessel at a rate substantially equal to a rate of addition of such components to the while maintaining temperature and pressure in the vessel at a desired constant level (page 11, lines 7-31).

It would have been obvious to one with ordinary skill in the art to include such because Wilson et al teaches the importance of control (col 11, lines 9-10).

3. Claims 3-4, 11-13, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sievers et al in view of Wilson et al (EP '424) as applied to claims above, and further in view of Smith.

Sievers et al and Wilson et al (EP '424) do not disclose restrictive passage as claimed and producing from the discharge device shaping as further claimed.

Smith discloses compressed fluid, solvent and the desired substance exhausted through a restrictive passage to a lower pressure whereby the compressed fluid is transformed to a gaseous state (fig 5). The restrictive passage includes a discharge device that produces a shaped beam of particles of the desired substance at a point beyond an outlet of the discharge device, where the fluid is in a gaseous

state at a location before or beyond the outlet of the discharge device ( 114). The cone angle appears to be within that as recited by applicant.

It would have been obvious to one with ordinary skill in the art to include restrictive passage as claimed and producing from the discharge device shaping as claimed because Smith teaches the importance of control.

4. Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sievers et al in view of Wilson et al (EP '424) as applied to claims above, and further in view of Fulton et al.

Sievers et al and Wilson et al (EP '424) do not disclose electrical force applied to the desired substance, or particle dimensions of claims 6-10.

Fulton et al discloses electrical force (para 0022) and particle dimensions covering claims 6-10. The reference teaches that nano-sized particles are generated by rapid expansion of supercritical fluids in such coating systems, citing particle sizes less than 1 micron, and specifically 20-200 nm, which overlaps the claimed ranges

It would have been obvious to one with ordinary skill in the art to include electrical force (as per claim 5) is because Fulton teaches finer control from electrostatic process (para 0003).

It would have been obvious to one with ordinary skill in the art to include the particule dimensions calimed because Sievers teaches particle sizes formed under supercritical spraying are consistent, so narrow particle size distributions would have

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been expected in the combined process of the prior art. It would also be obvious to one with ordinary skill in the art because of the desire for a smooth final product.

5. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sievers et al in view of Wilson et al (EP '424) as applied to claims above, and further in view of Fu et al.

Sievers et al and Wilson et al (EP '424) do not disclose a dye used in a ink jet printing process.

Fu et al discloses a dye in a ink jet printing process (para 0031).

It would have been obvious to one with ordinary skill in the art to include a dye used in a ink jet printing process because Fu et al teaches supercritical fluid used as a solvent (para 0031)

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 2, 6-10, 14, 17, 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4-9, 11, 12 of copending Application No. 10/815,026. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variations of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1, 2, 6-10, 14, 17, 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9-18 of copending Application No. 10/814,354. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variations of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

9. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 571-272-6739. The examiner can normally be reached on about 7:30 am to 5:00 pm (Mon. thru Thurs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alain L. Bashore  
Primary Examiner  
Art Unit 1762